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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,872	06/14/2001	Bhupesh Gupta	AUS920010383US1	8222

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EXAMINER

REFAI, RAMSEY

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

87

Office Action Summary

Application No.

09/881,872

Applicant(s)

GUPTA, BHUPESH

Examiner

Ramsey Refai

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Responsive to Amendment received on March 14, 2005.

Claims 1, 4, 6, 7, 10, 11, 14-17, 20-22, 25-28, 31-32, 35-38 and 41 have been amended.

Claims 1-41 remain presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4-9, 11, 16-19, 21-22, 25-30, 32, and 35-40 rejected under 35 U.S.C. 102(e) as being anticipated by Gilbert (U.S. Patent No. 6,529,942).

4. As per claim 1, Gilbert teaches a method of formatting an electronic mail message, comprising:

retrieving one or more recipient profiles from storage (**column 5, lines 49-63, column 7, lines 47-55, column 9, lines 6-11**; mail server reformats the content of the message by referring to profiles stored on the mail server that matches the recipient's user name to the identifier code, which represents the format specific to that corresponding user), wherein

each recipient profile within the one or more recipient profiles identifies an electronic mail message format for a corresponding recipient (**column 3, lines 3 – 22**);

identifying a recipient of an electronic mail message (**column 3, lines 3 – 5**); ; and

formatting content of the electronic mail message based on a recipient profile from the one or more recipient profiles corresponding to the identified recipient (**column 5, lines 49-63, column 7, lines 47-55, column 9, lines 6-11, column 3, lines 3 – 22**); .

5. As per claim 4, Gilbert teaches an electronic mail message directed to a plurality of designated recipients, and wherein formatting the electronic mail message includes identifying a set of compatible electronic mail format settings from among the content of electronic mail format settings of the designated recipients (**column 4, lines 16-30**).

6. As per claim 5, Gilbert teaches if a set of compatible electronic mail format settings cannot be identified from among the electronic mail format settings of the designated recipients, a default set of electronic mail format settings is used to format the electronic mail message (**column 7, lines 47-48**).

7. As per claim 6, Gilbert teaches electronic mail format settings include at least one of closing information, stationery, or whether to use spell check (**column 6, lines 38-67, Figure 3, column 4, lines 64-66; user can select specific text in message to reformat. Also teaches spell checking**).

8. As per claim 7, Gilbert teaches electronic mail message is directed to a plurality of designated recipients (**column 3, lines 13-16**), and wherein the electronic mail message is replicated into a different version of the electronic mail message for each of the plurality of designated recipients based on the one or more recipient profiles such that the content of each version of the electronic mail message is the same but the format is specific to the electronic mail format of a corresponding recipient profile (**column 1, lines 54-61, column 3, lines 11-16, and column 4, lines 16-30**).

9. As per claim 8, Gilbert teaches an electronic mail message is replicated in response to a user entering a command to transmit the electronic mail message (**column 1, lines 58-61**).

10. As per claim 9, Gilbert teaches an electronic mail message is replicated in response to a command entered by a user, and wherein the user may review the versions of the electronic mail message prior to transmitting them (**column 1, lines 39-42; teaches that a user must view multiple versions of a message**).

11. As per claims 11, 16-19, 21-22, 25-30, 32, and 35-40, these claims fail to add any further limitations and contain the same limitations as claims 1-9 above, therefore are rejected under the same rationale.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2-3, 10, 12-15, 20, 23-24, 31, 33-34, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (U.S. Patent No. 6,529,942) in view of Schuetze et al (U.S. Patent No. 6,101,320).

14. As per claim 2, Gilbert fails to teach that one or more recipient profiles include a recipient group format setting corresponding to a plurality of recipients, and wherein the recipient group format setting identifies electronic mail format settings that are common to the plurality of recipients.

15. However, Schuetze et al teach a routing unit that determines the identity of the recipient's organization and then determines the format used by the recipient organization (**column 5, lines 43-46**). A memory unit stores information regarding the email format of the recipient's organization (**column 6, lines 1-16**). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Gilbert and Schuetze et al because Schuetze et al's use of sending an email in a specific format to a recipient based on the recipients organization in Gilbert's method would allow an email sender from a different organization to send an email in a format that the recipient's of another organization can view and understand.

16. As per claim 3, Gilbert fails to teach one or more recipient profiles include a domain name category format setting corresponding to a plurality of recipients, and wherein the domain name category format setting identifies electronic mail format settings that are common to the plurality of recipients.

17. However, Schuetze et al teach a routing unit that determines the identity of the recipient's organization using the domain name of the organization (**column 5, lines 1-3**) and then determines the format used by the recipient organization (**column 5, lines 43-46**). A memory unit stores information regarding the email format of the recipient's organization (**column 6, lines 1-16**). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Gilbert and Schuetze et al because Schuetze et al's use of sending an email in a specific format to a recipient based on the recipients organization in Gilbert's method would allow an email sender from a different organization to send an email in a format that the recipient's of another organization can view and understand.

18. As per claim 10, Gilbert teaches an electronic mail message is directed to more than one designated recipient (**column 3, lines 13-16**).

19. Gilbert fails to teach an electronic mail message includes identifying a common set of electronic mail format settings for the more than one designated recipient, and wherein identifying a common set of electronic mail format settings includes: identifying at least one of a group set of electronic mail content format settings, a domain name category set of electronic mail content format settings, and an individual set of electronic mail format settings for each of

the at least one designated recipient; comparing each set of electronic mail format settings of each of the at least one designated recipient to each set of electronic mail content format settings of each other recipient of the at least one designated recipient to identify matching sets of electronic mail format settings; and using the matching sets of electronic mail content format settings to reformat the electronic mail message.

20. However, Schuetze et al teach electronic mail message includes identifying a common set of electronic mail content format settings for the more than one designated recipient (**column 4, line 61 – column 5, line 3**), and wherein identifying a common set of electronic mail content format settings includes: identifying at least one of a group set of electronic mail format settings (**column 5, lines 43-46**), a domain name category set of electronic mail content format settings (**column 5, lines 1-3**), and an individual set of electronic mail format settings for each of the at least one designated recipient (**column 4, line 61 – column 5, line 3**); comparing each set of electronic mail content format settings of each of the at least one designated recipient to each set of electronic mail content format settings of each other recipient of the at least one designated recipient to identify matching sets of electronic mail content format settings; and using the matching sets of electronic mail content format settings to reformat the electronic mail content message (**column 9, line 66-column 10, line 15; shows that users in an organization would be grouped as one organization; therefore messages sent to recipients of the same organization would be sent in a message of the format of the recipients' organization**). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Gilbert and Schuetze et al because Schuetze et al's use of sending an email in a specific format to a recipient based on the recipients organization in Gilbert's method would

allow an email sender from a different organization to send an email in a format that the recipient's of another organization can view and understand.

21. As per claims 12-15, 20, 23-24, 31, 33-34, and 41, these claims fail to add any further limitations and contain the same limitations as claims 2-3 and 10 above, therefore are rejected under the same rationale.

Response to Arguments

22. Applicant's arguments have been fully considered but they are not persuasive.

- In the remarks, the applicant argues in substance that:
 - a. Gilbert does not teach retrieving one or more recipient profiles from storage and formatting content of the electronic message based on a recipient profile corresponding to the intended recipient;
 - b. Schuetze does not teach formatting the content of an email message but rather is concerned with the transmission format expected by the recipient's electronic mail system;
 - c. Gilbert fails to teach the electronic mail message format settings include at least one of closing information, stationary or whether to use spell check.
- In reply to:
 - a. Examiner respectfully disagrees because although the word "profile" is not used, the functions of a profile are used in **mail server 11**. The mail server generates a properly formatted message for each recipient based on the matched identifier code to the

recipient's user name in the mail server's memory. (See column 5, lines 49-63, column 7, lines 47-55, column 9, lines 6-11.)

b. Examiner respectfully disagrees because changing the transmission format of a message would inherently change all parts of the message, including the content.

c. Examiner respectfully disagrees because Gilbert teaches that a user can select the desired text to be formatted from any portion of the content of the message. The software also allows the user to use spell check. (See column 4, lines 64-66; column 6, lines 38-67, Figure 3).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramsey Refai
Examiner
Art Unit 2154

RR
June 8, 2005



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